APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,571	03/09/2004	Kenneth J. Mackin	343328001US2	2498

			EXAMINER
25096	7590	10/04/2006	BUTLER, DENNIS

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

ART·UNIT	PAPER NUMBER
2115	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 September 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _37-83_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _37-83_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _09 March 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _(9/27/04)(10/17/05)_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1.   This action is in response to the amendment received on September 23, 2005.

Claims 37-83 are pending. Claims 1-36 have been canceled. This application is a

continuation of application 10/319,437, now U.S. Patent 6,728,877, which is a

continuation of application 09/300,862, now abandoned.

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 38-40, 48-61, 63-65, 70-73 and 77-83 are rejected under 35 U.S.C. 112,

first paragraph, as failing to comply with the enablement requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to

enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention. The specification fails to describe how to

inject configuration settings into a target computer and how to make an injection

application that injects the settings into the target computer as recited in claims 38-40,

48-50, 53-54, 63-65, 70-73, 77-78 and 82-83. The specification fails to describe how to

use retrieved configuration settings to control the operation of the target computer as

recited in claims 51-61 because there is no description of how the settings are

converted/injected so that they are usable by the target computer. The specification fails

to describe how to make the means for providing the target computer the configuration

settings so that the personality of the target computer is transitioned based on the

personality of the source computer as recited in claims 79-83. The specification merely

recites functional desired results and does not enable one of ordinary skill in the art to make and/or use the invention without undue experimentation.

The examiner did not find any description of how to infuse the configuration settings on the target computing system. The specification merely describes that an injection application infuses the target computer with "manipulated" configuration settings from the source computer. The injection application reads and executes the list of commands from the transition package to transition the configuration to the target computer. No descriptions of the commands are provided in the specification. No descriptions of how to transition the configuration settings so that they can be used by and control the target computer are provided in the specification. The specification merely describes that such a transition can be performed without describing how. Since there is no description of how to infuse/convert the configuration settings, there is also no description of how to use the configuration settings on the target computer so that its personality is transitioned based on the personality of the source computer.

Applicant's specification recites numerous embodiments for transitioning configuration settings from numerous combinations of source and target computers and infusing the settings in numerous ways. The source and target computers and the transitioning and infusing blocks/steps are all complex assemblages, the coordination and interaction of these components in the numerous embodiments recited in the specification are clearly complex.

The examiner should determine whether certain of the hardware or software

components (the injection step and injection application) depicted as block

elements (element 24 of figures 1 and 7, step 74 of figure 5 and step 98 of

figure 6B) are themselves complex assemblages which have widely differing

characteristics and which must be precisely coordinated with other complex

assemblages (the source computer, transitioning the settings and the target

computer). Under such circumstances, a reasonable basis may exist for

challenging such a functional block diagram form of disclosure. In re Ghiron,

442 F.2d 985, 169 USPQ 723 (CCPA 1971) and In re Brown, 477 F.2d 946,

177 USPQ 691 (CCPA 1973).

The primary purpose of our patent system is not reward of the individual but the

advancement of the arts and sciences. Its inducement is directed to disclosure of

advances in knowledge which will be beneficial to society; it is not a certificate of merit,

but an incentive to disclosure. Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S.

327, 65 USPQ 297 (1945). The ultimate goal of the patent system is to bring new

designs and technologies into the public domain through disclosure. Bonito Boats, Inc.

v. Thunder Craft Boats, Inc., 489 U.S. 141, 9 USPQ 2d 1847 (1989).

4.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

5.   Claims 37, 41-47, 62, 67-69 and 74-76 are rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,

6-8, 11, 16-18 and 25 of U.S. Patent No. 6,728,877. Although the conflicting claims are

not identical, they are not patentably distinct from each other because they are directed

to substantially the same invention including identifying locations of configurations,

selecting/indicating settings that can be extracted and extracting the selected settings.

The claims differ from the patent in that the patent does not explicitly recite storing the

extracted settings on a storage device. However, the patent recites that the extracted

settings are provided to a target computer and it would have been obvious to provide

the settings to the target computer using a storage device. In addition, the application

includes claims that are generic to the species of invention covered by the patent and

the generic invention recited in the applications claims is anticipated by the species of

the patented invention. Claims 37 and 62 of the application correspond to claims 1 and

16 of the patent. Claims 41-47 and 67-69 of the application correspond to claims 3 and

6-8 of the patent. Claim 74 of the application correspond to claims 1, 11, 16 and 25 of

the patent. Claims 75 and 76 of the application correspond to claims 2-3 and 17-18 of the patent.

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9.   Claims 51-53, 62-64, 66, 70, 74-77, 79-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al., U. S. Patent 6,161,176.

Per claims 51-53, 62-64, 70, 74, 77, 79 and 82:

A)   Hunter et al teach the following claimed items:

1.   providing configuration information identifying locations of configuration

settings with INI file 74 of figures 2 and 3 and at column 6, line 55 – column 7,

line 3;

2.   providing a selection of configuration settings to be extracted at column 3,

lines 17-33, at column 6, lines 42-54 and at column 12, lines 52-57;

3.   extracting the selected configuration settings from the locations of the

source computer (computer 1) at column 9, lines 48-64;

4.   storing the extracted settings on a storage device in a format that can be

used by the target computer (computer 2) to control its operation with settings file

90 of figures 3 and 4 and at column 10, lines 17-27;

5.   . providing the target computer with the configuration settings, transitioning

the target computer based on the personality of the source computer and using

the settings to control the operation of the target computer with figures 4 and 6,

at column 3, lines 3-16, at column 11, lines 6-47 and at column 13, lines 31-67;

6.   injecting the configuration settings into the target computer using an

injection application (wizard) with figures 4 and 6, at column 3, lines 3-16, at

column 11, lines 6-47 and at column 13, lines 31-67.

Per claim 66:

Hunter describes receiving a user selection of configuration settings stored on the storage device that are to be injected into the target computer at column 12, lines 24-42.

Per claims 75-76 and 80-81:

Hunter describes personality objects of the source computer that specify configuration settings with wizard 38 of computer 1 in figures 2, 3 and 5 and at column 12, line 52 – column 13, line 30.

10.   Claims 37-50, 54-61, 65, 67-69, 71-73, 78 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al., U. S. Patent 6,161,176.

Per claim 37:

A)   Hunter et al teach the following claimed items:

1.   providing configuration information identifying locations of configuration settings with INI file 74 of figures 2 and 3 and at column 6, line 55 – column 7, line 3;

2.   receiving a selection of configuration settings to be extracted at column 3, lines 17-33, at column 6, lines 42-54 and at column 12, lines 52-57;

3.   extracting the selected configuration settings from the locations of the source computer (computer 1) at column 9, lines 48-64;

4.   storing the extracted settings on a storage device in a format that can be used by the target computer (computer 2) to control its operation with settings file 90 of figures 3 and 4 and at column 10, lines 17-27.

B)   The claims differ from Hunter et al in that Hunter et al fails to explicitly

teach displaying an indication of configuration settings that can be extracted from

the source computer as claimed.

C)   However, Hunter describes that a user creates a settings file of the users

settings using a wizard application at column 3, lines 17-33, at column 6, lines

42-54 and at column 12, lines 52-57. The wizard application queries the user in

natural language and performs a more complex task in response to the users

input. Therefore, it would have been obvious to one having ordinary skill in the art

at the time the invention was made to have the wizard query the user by

displaying an indication of configuration settings that can be extracted from the

source computer in order to provide the user a list of the possible configurations

that can be extracted that the user can select from rather than make the user

develop the list themselves.

Per claims 38-40, 48-50, 54, 65, 78 and 83:

Hunter describes injecting the configuration settings into the target computer

using an injection application (wizard) with figures 4 and 6, at column 3, lines 3-

16, at column 11, lines 6-47 and at column 13, lines 31-67. Hunter does not

describe locating the injection application (wizard) on the storage device.

However, Hunter describes that the injection application is located on a storage

device on the target computer with wizard 38 of figure 4, at column 11, lines 15-

32 and with figure 6. It would have been obvious to one of ordinary skill in the art

to locate wizard 38 on memory device 88 of computer 2 in order to provide

computer 2 with the wizard application.

Per claims 41-47, 55-61, 67-69 and 71-73:

Hunter describes using a computer that includes operating system 35,

application programs 36 and both local and wide area network connections 51,

52 with figure 1. Claims 41-47, 55-61, 67-69 and 71-73 recite well known

programs and settings commonly provided with operating systems and network

communication programs and it would have been obvious to one of ordinary skill

in the data processing art to extract configuration settings from such programs in

order to transfer the users custom settings to another computer.

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dennis M. Butler whose telephone number is 571-272-

3663. The fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Dennis M. Butler

Dennis M. Butler
Primary Examiner
Art Unit 2115